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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,321	04/12/2004	Andre Rosowsky	56369 (70157)	5857

21874 7590 04/10/2006

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/824,321	Applicant(s) ROSOWSKY ET AL.	
	Examiner Venkataraman Balasubramanian	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-49 and 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 is/are allowed.
- 6) ☐ Claim(s) 39-49 and 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response, which included cancellation of claims 1-37, 50-54 and amendment to claims 38, 39, 41, 44, 46, 47, 49 and 55, filed on 12/23/2006, is made of record. Claims 38-49 and 55 are pending. In view of applicants' response, the following apply.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 40 is indefinite as it recites, "wherein the compound is a lipophilic inhibitor of dihydrofolate reductase". As recited, it appears that one need to experiment and find such a compound from the genus of claim 39. In addition, a compound is a compound irrespective of its functional attributes. A compound is defined clearly by its structural make-up and difference between two compounds for prior art purpose is based on the structure. See *Intirtool, LTD. V. Texar Corp.*, 70 USPQ2D 1780. Note court held that " In general, a claim preamble is limiting if recites essential structure or steps or if it is necessary to give" life, meaning, and vitality to claim.'.... However, if the body of the claim describes a structurally complete invention such that deletion of the preamble phrase does not effect the structure or steps of the claimed invention,' the preamble is generally not limiting

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unless there is clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art.””

Instant claim is a compound claim and is clearly defined by a structure namely a bicyclopymidine core with specific substituents. Omission of the attributes to the compound of genus of claim 40 would not alter the structure of the compound.

Hence, claims 40 is a duplicate of claim 39.

This rejection is same as made in the previous office action. Applicants' traversal to overcome this rejection is noted but deemed as no persuasive. Applicants have argued that claim 40 further limits claim 39 and it is true. But applicants have not pointed out wherein in specification a distinction between "lipophilic" and "non-lipophilic" inhibitors are disclosed and how to distinguish them given the genus of claim 39. Thus, without such a teaching compound of genus 39 , it is not possible to know whether claim 40 is further limiting claim 39 or not. Hence, this rejection is maintained.

In view of applicants' amendment, all other 112 second and first paragraph rejections have been obviated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39- 49 and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Broughton et al. Antimicrobial Agents and Chemotherapy, 1348-1355, 1991.

Broughton et al. teaches several 2,4-amino-pyrimidines, which include a compound claimed in the instant invention for treating *Pneumocystis carinii* infections. See entire document, especially see Table 8, and compound 351521.

In view of applicants' amendment to limit R³ to H, this rejection is deemed as obviated.

However, the following 103 rejection apply.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 39-49 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broughton et al. Antimicrobial Agents and Chemotherapy, 1348-1355, 1991.

Broughton et al. teaches several 2,4-amino-pyrimidines, which include a compound claimed in the instant invention for treating *Pneumocystis carinii* infections. See entire document, especially see Table 8, and compound 351521.

Instant compounds require a carboxyl group at 2 or 4 position for R₁ and an amino at other available position for R₂.

While said compounds don't anticipate the scope of instant claims, they are very closely related, being homolog that is compounds that differ in methyl in the reference on vs. H in the instant on the phenyl of the quinazoline. However, homologs and compounds that differ only by CH₃ Vs H are not deemed patentably distinct absent evidence of superior or unexpected properties. See *In re Wood* 199 USPQ 137; *In re Lohr* 137 USPQ 548.

Thus it would have been obvious to one skilled in the art at the time of the invention was made to expect instant compounds to possess the utility taught by the applied art in view of the close structural similarity outlined above.

Allowable Subject Matter

Claim 38 is allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any

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inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

Venkataraman Balasubramanian
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4/1/2006